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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/689,592 | 10/13/2000 | Hiroyuki Tanimura | 2185-0475P | 8209 |

7590 09/25/2002
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| EXAMINER | |
| REDDICK, MARIE L | |
| ART UNIT | PAPER NUMBER |
| 1713 | 8 |

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|-----------------|-----------------|
| | 09/689,592 | TANIMURA ET AL. |
| Examiner | Art Unit | |
| Judy M. Reddick | 1713 | |

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10/13/00; 1/26/01; 1/31/01; 12/12/01; 1/9/01 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6 . 6) Other: _____ .

DETAILED ACTION

Election/Restrictions

1. **Restriction to one of the following inventions is required under 35 U.S.C. 121:**
 - I. **Claims 1-4, drawn to a process for producing a polyolefin-based resin composition, classified in class 524, subclass 515.**
 - II. **Claims 5 and 6, drawn to a process for producing a polyolefin-based resin film, classified in class 264, subclass 210.1.**
 - III. **Claims 7 and 8, drawn to a resin film, classified in class 428, subclass 500.**
2. **The inventions are distinct, each from the other because:**
3. **Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the Group I invention has separate utility such as it could be used in an injection molding process. See MPEP § 806.05(d).**
4. **Inventions Group II and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by injection molding polyolefin-based resin into a flat, sheet-like piece, stretching to orient and shaping the piece into a film. It is noted that claims 7 and 8 are product by process claims and that in product-by process type claims only the physical characteristics of the formed products are considered patentable relevant to the claim.**
5. **Inventions Group I and Group III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a composition that could be used to make injection molded products and the inventions are deemed patentably distinct since there is**

nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. The intermediate product(polyolefin-based composition) is in mutually exclusive relationship with the final product(resin film) as per presumably a reaction taking place upon film formation engendering a final product substantially different from the intermediate product, i.e., the intermediate product loses its identity upon formation of the final product.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Mr. John W. Bailey on 08/30/02 a provisional election was made WITH traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-8 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

9. The information disclosure statements filed 01/26/01, 01/31/01 and 12/12/01 have been considered and placed in the application file.

Priority

10. **Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the fil .**

Specification

11. **The disclosure is objected to because of the following informalities: On page 2 @ line 18, "the that" should read "to that"..**

Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) **The recited "fine particles containing 0.10 to 90 % by weight of a volatile component" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact entity that said contents are being base on, i.e., total resin composition, polyolefin-based resin or else.**

B) **The recited "volatile component of 0.10 to 80 % by weight" per claim 2 constitutes indefinite subject matter as per reasons set forth in item A) supra.**

Claim Rejections - 35 USC § 102

14. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1),

(2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4 are rejected under 35 U.S.C. 102(e or b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Otawa et al(U.S. 4,818,785), Yamazaki et al(6,183,866) or EP 659,823(Seiichiro et al).

Each of Otawa et al, Yamazaki et al and Seiichiro et al disclose polyolefin-based resin compositions and processes of producing said polyolefin resin-based compositions wherein said processes involve, basically, melt kneading a polyolefin-based resin and fine polymer particles containing a volatile component. Each of patentees therefore anticipate the instantly claimed invention with the understanding that the components of each of patentees overlaps in scope with the claimed compositional components, in both content and character. See, e.g., the Abstract, cols. 3-13 and the Runs of Otawa et al, the Abstract, the Runs and claim 11 of Yamazaki et al and the Abstract and pages 2-9, Runs and Claims, inclusive of Seiichiro et al.

While patentees are silent relative to the use of the disclosed "polymer fine particles" as "an antiblocking agent", the disclosure discloses a new property or use for a previously known

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compound cannot impart patentability to the claims to that compound, even if the property or use is unobvious from the prior art (In re Schoenwald, 22 USPQ 1671).

Conclusion

17. The additional prior art listed and not relied upon is considered merely illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
September 23, 2002